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Fig. 2B is a detailed view of the other plastic frame showing the energy director utilized in the sonic welding process;--

REMARKS

Reconsideration of this application is respectfully requested.

A. Consent of the Assignee

Applicants submit herewith a new Consent of Assignee (Exhibit A) and an appropriate Certificate under 37 C.F.R. § 3.73 (Exhibit B) to establish ownership in this application. Applicants believe that these papers comply with all formal requirements with respect to ownership, assignment, and consent for this reissue application.

B. Offer to Surrender

Applicants will file an appropriate Offer to Surrender along with a copy of the original patent after an indication that the claims are in condition for allowance.

C. The Objection to the Drawings

Applicants submit herewith a Submission of Proposed Drawing Amendment to show the energy director element 22 that mates with energy director element 20. Applicants respectfully request entry of the amendment to the drawings, which will overcome the objection.

D. The Double-Patenting Rejection

Claims 1 - 23 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 16 - 49 of copending application No. 09/023,790. Applicants have canceled claims 16 - 49 from the copending application. Thus, the provisional rejection has been overcome.

E. The Recapture Rule

Claims 11 - 23 were rejected as being an improper recapture of claimed subject matter canceled from the original patent. More specifically, the Examiner has noted that an Examiner's Amendment in S.N. 08/092,012 added the requirement for the metal covers to be bent to conform to the shape of the frame.

Applicants have amended Claim 11 to include the requirement that the edges of the metal covers are bent to conform to a shape of the plastic frame, somewhat similar to the amendment entered in S.N. 08/092,012. Thus, the amended claims do not violate the recapture rule.

The Examiner also contends that in Serial No. 08/092,012, Amendment B, Paper No. 6, filed August 3, 1994, Applicants amended the claim to include the "the plastic frame elements being injection molded around a plurality of fingers" and then argued on pages 3 and 4 of the criticality of injection molding the invention. However, Applicants note that the amendments in Amendment B were a complete rewriting of then application claim 16 with no particular emphasis on "fingers." Further, the prosecution history clearly establishes that this amendment or rewriting of the claim is not the amendment that resulted in allowance of the application.

After filing of Amendment B, Paper No. 6, a telephone interview was held and Applicants and the Examiner agreed to again amend claim 16 as indicated in the Notice of Allowability dated October 21, 1994 and attached Examiner's Amendment. This new amendment to then application claim 16 (issued as claim 1) included the separate element of describing "each cover having a first side and a second side with a plurality of fingers extending from said sides and **wherein edges of the metal covers are bent to conform to the shape of the frame and said fingers are embedded in...**" (Emphasis added). The

amendment that resulted in the allowance was a description of the edges of the metal covers being bent to conform to the shape of the frame, which was also the reason for allowance in divisional application Serial No. 08/348,535. (See the prosecution history).

In order for the recapture rule to apply, the applicant must have clearly surrendered and canceled certain claim coverage from his claims in order to obtain allowance. *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984). In the present case, the description of multiple fingers was not an express cancellation or surrender of any subject matter, and is not the limitation that resulted in allowance of the claims. Thus, broadening of the claims to describe only having "a finger" does not violate the recapture rule.

F. The Rejections Based on Lack of Disclosure in the Specification

Claims 7 - 10, 15, and 18 - 23 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not described in the specification in such a way as reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse the rejections below.

1. The Finger Limitation (Claims 7, 15)

The Examiner states that the recitation in the claims for a single finger, or for a single finger or multiple fingers extending from only one side is new matter and that there is no suggestion of a single finger in the specification. Applicants respectfully submit that the Examiner is not applying the correct legal requirement and that the specification provides adequate support for this limitation.

The Federal Circuit recently addressed the requirements of § 251 and equated such requirements with the "written description" requirement of 35 U.S.C. § 112, paragraph 1. *Hester Industries Inc. v. Stein Inc.*, 46 USPQ2d 1641, 1651 (Fed. Cir. 1998); *In re Amos*, 21

USPQ2d 1271, 1274 - 75 (Fed. Cir. 1991). The essential inquiry in determining compliance with the "original patent" clause of § 251 or the "written description" requirement of § 112, paragraph 1, is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as being invented and disclosed by the patentees. *Id.*

The function of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application, of the specific subject matter later claimed by him. *In re Edwards*, 196 USPQ at 465, 467 (CCPA 1998). To comply with the written description requirement, it is not necessary that the application describe the claimed invention in *ipsis verbis*. *Id.* Indeed, it is immaterial how the application achieves compliance with the written description requirement. *In re Voss*, 194 USPQ 267, 271 (CCPA 1977); *In re Smith*, 178 USPQ 620 (CCPA 1973). Rather, "all that is required is that it [the specification] reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him." *Id.*

The Patent Office has the initial burden of presenting evidence or reasons why those skilled in the art would not recognize in the specification a description of the later claimed invention. *In re Voss*, 194 USPQ at 271.

Claim 7 recites "a finger extending from one of said sides" of each cover. As a starting point, the specification includes adequate support and disclosure for a package in which at least a finger extends from one of the sides. In other words, the specification describes and shows subject matter upon which the claims read. Further, there are no statements in the specification that state the invention is limited to a system that requires fingers on both sides.

As noted above, the Patent Office has the initial burden of presenting evidence or reasons why those skilled in the art would not recognize in the specification a description of the invention defined by the new claims. *In re Voss*, 194 USPQ at 271. Here, the Patent

Office has presented no evidence or reasons why those skilled in the art would believe that Applicants' invention requires fingers on both sides. Indeed, it is believed that one skilled in the art would recognize, upon reviewing the adequate disclosure of the claimed structure, that the positioning and number of fingers could be varied in different ways depending upon a particular application for which the device was used. Indeed, there is nothing in the specification to the contrary.

Moreover, the new claims all use the term "comprising" and are open-ended. Thus, none of the claims exclude a package including fingers on both sides. Rather, the claims cover a system that has a finger on at least one side as well as a package having fingers on both sides.

Applicants further note that this not a chemical case wherein one of the elements of the claims is critical to operation of the invention. For example, omission of the fingers from one side does not render the device inoperative. Thus, it cannot be argued that the specification requires fingers on both sides.

Most importantly, Applicants broadened claims are specifically permitted by the reissue statute. In particular, both the Federal Circuit and the CCPA have specifically held that applicants are entitled to submit broadened reissue claims which are broader than the embodiment shown in the specification. In *In re Rasmussen*, 211 USPQ 323, 326 (CCPA 1981), the CCPA reaffirmed that reissue claims may be broader than specific embodiments disclosed in the specification without adding new matter as follows:

"Broadening a claim does not add new matter to the disclosure. Disclosure is that which is taught, not that which is claimed. An applicant is entitled to claims as broad as the prior art and his disclosure will allow..."

As above indicated, that a claim may be broader than the specific embodiment disclosed in a specification in itself of no

moment. Indeed, the statutory provision for broadened claims in reissue applications is intended to meet precisely the situation in which a patentee has claimed 'less' than he had a right to claim. 35 USC 251." (footnote omitted).

The facts in *In re Rasmussen* are also instructive. The applicant's specification only described one specific method of using adhesive to stick two layers together. The applicant submitted broadened reissue claims which only described "adheringly applying" one layer to an adjacent layer and omitted certain steps. The CCPA reversed the rejection and held that the applicant was entitled to the broadened reissue claims.

In *In re Peters*, 221 USPQ 952 (Fed. Cir. 1983), the Federal Circuit specifically followed the above statement and ruling from *In re Rasmussen*, 211 USPQ 323. In that case, the patent disclosed a device including tapered tips, and the applicants sought broadened reissue claims that were read on both tapered and non-tapered tips. The Board affirmed the rejection based on 35 U.S.C. § 251 and § 112, first paragraph. However, the Federal Circuit reversed and, in accordance with *In re Rasmussen*, held that applicants were entitled to submit broadened reissue claims broader than the specific embodiment shown in the specification.

Likewise, the law here permits Applicants to submit reissue claims that are broader than the specific embodiment disclosed in the specification. *In re Rasmussen*, 211 USPQ at 326; *In re Peters*, 221 USPQ 952 (Fed. Cir. 1983).

2. The U-Shaped Edges of the Metal Cover (Claim 18)

In the Office Action, the Examiner contends that the U-shape described by claim 18 is new matter. Applicants respectfully submit that the drawings provide adequate disclosure for this claim limitation.

In particular, referring to Fig. 4, the entire ends of the metal covers each form a U-shape that encapsulates the plastic frame. One leg of the U runs along the top surface of the frame,

the base of the U runs along the edge, and the second leg runs along the interior of the frame member. This refers to the edge rather than just the finger as apparently referenced by the Examiner in the Office Action. In view of this description, the specification provides adequate support for the claim limitation.

Applicants note that the claimed invention need not be described in the application *ipsis verbis* (word-for-word), and that the PTO has the burden to give reasons why a description not word-for-word is insufficient. *In re Edwards*, 296 USPQ 465, 469 (CCPA 1978); *see also Ex parte Anderson*, 21 USPQ 1241, 1249 (BPAI 1991); *In re Herschler*, 200 USPQ 711, 717 (CCPA 1979); *In re Voss*, 194 USPQ 267, 271 (CCPA 1977). While the specification does not include the word-for-word language of claim 18, the original disclosure does clearly show that the inventors had possession of this material.

3. The Plane Bisecting the U-Shaped Edge (Claims 19, 21)

With reference to claims 19 and 21, the Examiner stated that the original disclosure does not disclose or suggest a plane bisecting the U-shaped edge. Applicants respectfully submit that the application does clearly convey to those skilled in the art the structure described by Claims 19 and 21.

With respect to the “plane bisecting the U-shaped edge at its terminal portion” as described in both Claims 19 and 21, the claim is merely setting up an imaginary reference point or plane that would be positioned on the end of the U-shaped edge. This limitation is similar to claims that describe elements of a structure with respect to a longitudinal axis, a base line, or the like. The claim language is not repeated in the specification word-for-word, but it is clear from the specification and drawings that there could be a reference point in the form of a plane that extends across the terminal ends of the U-shaped edges.

The plane is more clearly understood by viewing Fig. 2 in which the plane would be coincident with the surface 18 and energy director 20 would be an example of the "plastic perimeter surface" of claim 19 that is exposed and extending beyond the plane of the frame. Thus, the specification provides adequate support.

4. Partial Molding About the Edge (Claims 22, 23)

The Examiner has rejected claims 22 - 23 on the basis that the original disclosure does not disclose or suggest a frame partially molded about either the edge or a finger.

Applicants respectfully submit that the application does convey to those skilled in the art that the frame can be partially molded about the edge of the cover or finger. Referring to Fig. 4 of the disclosure, the frame elements are molded over and about only the fingers at the end of the fingers at the edge of the metal covers. In other words, the majority of the bent edge is not molded into the frame and only part of the edge (i.e., a portion of the finger) is molded into the frame. Also by viewing Fig. 3, it can be seen that the fingers extend from the edge of the frame beginning at a point designated by 26 in the upper right of that figure and extending to the terminal portion of the edge of the cover as shown by 26 at the upper or lower left of the figure. Thus, the disclosure fairly shows that the frame is partially molded about the edge of the metallic frame.

G. Enablement

Claims 7 - 23 were rejected under 35 U.S.C. § 112, first paragraph, based on lack of enablement. The specific rejections were based on: (a) the specification allegedly not enabling the securing of a single finger to the frame element as recited in Claim 7; (b) as not providing enablement for securing the edge (without the recitation of fingers) to the frame as recited in Claim 11; and (c) as not reasonably enabling securement of a U-shaped edge where one of the frame elements is injection molded while the other is molded as recited in claim 18.

Turning to the first ground for rejection, the Patent Office must acknowledge that the specification does adequately enable one skilled in the art to secure a single finger to a frame element as recited in Claim 7. Indeed, the specification adequately discloses and teaches how to secure multiple fingers to the frame element so it must also teach and enable how to secure a single finger to the frame. Thus, enablement rejection cannot stand.

Turning to the second ground for rejection, claim 11 does not describe "securing an edge (without the recitation of fingers) to the frame element as contended in the Office Action. To the contrary, claim 11 "the plastic frame elements are injection molded to secure the finger of each cover to the plastic frame element." In view of this clarification, Applicants respectfully submit that the rejection is moot.

Turning to the third ground of rejection, Applicants respectfully submit again that the Examiner misconstrues the actual claim language. Claim 18 describes "a frame element injection molded within the U-shaped edge of the metal cover." As clearly shown in Fig. 4, the frame is molded **within** the U-shaped metal edge. Although the claim does not specify that the second package has a frame element injection molded within a U-shaped edge, the claim may cover such an embodiment and is clearly enabled by the specification. Thus, the claimed structure is clearly shown, described and enabled.

H. The Indefiniteness Rejections

Claims 1 - 10, 12, 14, and 19 - 20 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

Claim 1 was rejected as being indefinite because it is allegedly unclear what is intended by the limitation "extends beyond the plane of the metal covers." The Examiner further states that "the plane" does not have proper antecedent basis.

Applicants note that in Attachment A filed with the reissue application, "the plane" was amended to read "a plane." Thus, the antecedent basis rejection is moot.

With respect to the indefiniteness rejection, Applicants note that the Patent Office originally believed this claim was definite since claim 1 issued with the underlying patent. The reason that the Patent Office found claim 1 definite before is that the plane refers to the horizontal plate portion above a base plate portion of the metal covers and substantially parallel to the horizontal metal to metal contacting of the surfaces of the covers such that a ***plastic perimeter surface is exposed*** above the flat plane of plastic frame elements. Indeed, this emphasized language appears directly in claim 1. This is also clearly shown in Figure 2 which shows the plastic frame having a flat perimeter surface and a flat plane and having an energy director extend beyond the plane of the metal cover so that the plastic perimeter surface is exposed.

Claim 12 is definite for the same reasons that claim 1 is definite.

Claims 14 and 20 include the term "energy director." The term energy director is clearly defined in the specification. See, for example, col. 3, lines 12 - 19 and col. 4, lines 8 - 11. Because the specification adequately defines this term, the claims are definite and comply with the provisions of § 112.

Claim 19 was objected to for its reference to the plane that bisects the U-shaped edge at its terminal portion. In the context of the specification and drawings, the claim makes it clear that the plane is an imaginary plane that fits on the flat U-shaped edge of the bent metal corner. One skilled in the art would understand this and the claim is therefore definite.

I. The Prior Art

Claims 11 - 13 and 17 under 35 U.S.C. § 102 as being anticipated by *Simmons et al.* (U.S. 5,339,222).

As discussed above in connection with the recapture rule, Applicants have amended Claim 11 to describe that the "edges of the metal covers are bent to conform to a shape of the frame". Applicants respectfully submit that amended Claim 11 is patentably distinguishable from the cited reference.

Claim 11 specifically describes "a plastic frame element associated with each of the covers" (emphasis added). The plastic frame elements associated with each cover permit the covers to be secured together by attaching the two plastic frames together.

In stark contrast to the claimed invention, *Simmons et al.* shows two metal covers with a plastic frame on only one of the metal covers. The reference therefore does not anticipate Claim 11. Further, the reference cannot render Claim 11 obvious since there is no suggestion or motivation contained in the reference that would suggest the one to drastically modify the device to include two plastic frames. *In re Mills*, 916 F.2d 680, 682 16 USPQ 2d 1430, 1432 (Fed. Cir. 1990) (although a prior art device "may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so."); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398 (Fed. Cir. 1989) ("Although the commissioner suggests that [the structure in the primary prior art reference] could be readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'"); *Ex parte Dussaud*, 7 USPQ 2d 1818, 1820 (PTO Bd. Pat. App. & Int'l 1988) ("The mere fact that the prior art could be modified in the manner proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification").

In addition, Claim 11 specifies that the "edges of the metal covers are bent to conform to the shape of the frame." Thus, in addition to specifying two plastic frame elements, it

specifies that the edges of the metal covers are bent to conform to the shape of the frame. In stark contrast, *Simmons et al.* does not teach two plastic frame elements nor does it teach bending the edges of the metal frames to conform to two such plastic elements.

In the Office Action, the Examiner acknowledges that *Simmons et al.* does not teach injection molding of the frame elements. The Examiner then argues that product by process limitation cannot serve to distinguish a product claim from an anticipating product. Applicants respectfully submit that that is not what Applicants are trying to do here.

In particular, Claim 11 specifies that the “plastic frame elements are injection molded to secure the finger of each cover to the plastic frame element.” This means that the plastic is injected molded over the fingers, which is a physical attribute of the product. Rather than talking about the process by which it is formed, the claim talks about the final product configuration where the plastic is injected molded over the fingers. In contrast, *Simmons et al.* does not teach injection molding of frame elements as acknowledged in the Office Action.

Further, the Examiner’s contention that the PCM holder disclosed in *Simmons et al.* is indistinguishable from the invention as claimed. Because the top cover of *Simmons et al.* is clamped over the bottom cover, the top cover requires major longitudinal signs to go over and surround the bottom sides of the bottom cover. This provides a distinguishing demarcation from the present invention that does not result in the edges of the metal covers overlapping from the first side to the second side as is present in the embodiment described in claim 11. Even when the covers of the present invention are “fused together”, the resultant package would be easily distinguishable from the clamped covers of the device taught by *Simmons et al.*

In view of the foregoing, Applicants respectfully submit that Claims 11-16 are patentably distinguishable from the reference cited by the Examiner.

J. The Reissue Oath

Claims 1 - 23 were rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. § 251. Specifically, the Examiner has stated that Applicants' reason for filing a reissue application is not consistent or commensurate with the scope of Claims 11 - 14 and 16 - 23. The Examiner further refers to paragraph 27 of the declaration in the rejection.

Applicants respectfully submit that this rejection is moot in view of the change in the law that no longer requires an applicant to explain the reasoning of why a reissue application is filed. Under the new rules, it is enough that the patentee alleged at least one error in the patent and Applicants have sufficiently done that.

Further, Applicants respectfully submit that the statement in paragraph 27 of the declarations is accurate. The point being made in paragraph 27 is that the original independent claims should have read on preferred embodiments with a single finger. The new claims address this deficiency in original claim 1 by referring to "a finger" and stating that it extends from at least one of the metal covers. Notably, the new reissue claims read on both embodiments in that they cover devices in which a finger extends from one of the covers or both of the metal covers.

In view of the foregoing, Applicants respectfully submit that the reissue oath is proper.

K. Explanation of Support for Amended Claims

In the Office Action, the Examiner objected to the Amendment for failing to provide an explanation of the support and the disclosure for each amendment, citing 37 C.F.R. § 1.121(b)(2)(III). A explanation of the support for each of the new claims is set forth below.

Claims 7 - 10 find support in original claims 1 - 6 and also find support in the specification at col. 2, line 57 - col. 3, line 61, among others.

Claims 11 - 17 find support in original claims 1 - 6 and also find support in the specification at col. 2, line 57 - col. 3, line 61, among others.

Claims 18 - 23 find support in original claims 1 - 6 and also find support in the specification at col. 2, line 57 - col. 3, line 61, among others.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that this application is now in condition for allowance. Favorable and early action are therefore respectfully solicited. If the Examiner believes that discussing this application would be helpful, he is invited to telephone the undersigned attorney at the number given below.

Respectfully submitted,


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on September 3, 1999.


Joseph P. Reagan